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NOTICE OF ALLOWANCE AND FEE(S) DUE

26192 7590 12/28/2010

FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

EXAMINER

BRANDENBURG, WILLIAM A

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 12/28/2010

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,681	12/31/2003	Ross Koningstein	16113-0639001	1968

TITLE OF INVENTION: SYSTEM AND METHOD FOR ENABLING AN ADVERTISEMENT TO FOLLOW THE USER TO ADDITIONAL WEB PAGES

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$300	\$0	\$1810	03/28/2011

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: **Mail** **Mail Stop ISSUE FEE**
Commissioner for Patents
P.O. Box 1450
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or Fax **(571)-273-2885**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

26192 7590 12/28/2010
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PO BOX 1022
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Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10748,681 12/31/2003

Ross Koningstein

16113-0639001

1968

TITLE OF INVENTION: SYSTEM AND METHOD FOR ENABLING AN ADVERTISEMENT TO FOLLOW THE USER TO ADDITIONAL WEB PAGES

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$300	\$0	\$1810	03/28/2011

EXAMINER	ART UNIT	CLASS-SUBCLASS
BRANDENBURG, WILLIAM A	3622	705-014000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a **Customer Number is required.**

2. For printing on the patent front page, list

- (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 _____
 (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 _____
 3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY AND STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. **Change in Entity Status** (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____ Date _____
 Typed or printed name _____ Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.**

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26192	7590	12/28/2010	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			BRANDENBURG, WILLIAM A	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 12/28/2010

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 1071 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 1071 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Notice of Allowability**Application No.**

10/748,681

Applicant(s)

KONINGSTEIN, ROSS

Examiner

WILLIAM A. BRANDENBURG

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 09/14/2010.
2. ☒ The allowed claim(s) is/are 1-17 and 35-55.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

John Van Bramer
/John Van Bramer/
Primary Examiner, Art Unit 3622

DETAILED ACTION

Response to Amendment

1. The amendment filed on 09/14/2010 is sufficient to overcome the previously applied rejection of claims 1, 35 and 52-53 over the reference of **Petropoulos et al.** (US 2003/0146939 A1).

Claim Objections

2. The amendment filed on 09/14/2010, has corrected the claim objections identified in the Office Action dated 07/22/2010. Thus, the Examiner hereby withdraws the claim objections of claims 1, 35 and 52-53 that were raised in the Office Action dated 07/22/2010.

Claim Rejections - 35 USC § 112

3. The amendment filed on 09/14/2010, has corrected the 35 U.S.C. 112 deficiencies identified in the Office Action dated 07/22/2010. Thus, the Examiner hereby withdraws the 35 U.S.C. 112 second paragraph rejections of claims 1, 35 and 53 that were raised in the Office Action dated 07/22/2010.

Allowable Subject Matter

4. Independent claims 1, 35 and 52-53 are allowed, and therefore the respective dependent claims 2-17, 36-51 and 54-55 are also allowed.

Examiner's Statement of Reasons for Allowance

5. The following is an examiner's statement of reasons for allowance of independent claims 1, 35 and 52-53 over the applied reference of **Petropoulos et al. (US 2003/0146939 A1) (hereinafter Petropoulos)**:

(1) The applied reference of Petropoulos teaches displaying preview information associated with each item on a list of search results. The preview information is a "preview window" containing some relevant preview information, such as a readable size image of the actual page or document associated with an item in the results lists. Petropoulos further teaches a dedicated preview icon that functions as a menu for controlling previewing or that the icon can transform into such a menu ([0010], Fig. 1, "53,55,63/64").

While considering the limitations of the instant invention, the Examiner understands the claimed limitations to have the following equivalencies:

compact format: search result, Fig. 1, "53"

expansion icon: preview icon, Fig. 1, "63/64"

expanded format: preview window, Fig. 1, "55"

Based on this understanding, it is clear that the electronic advertisement is in two formats. Furthermore, it is clear that upon interaction with the disclosed preview icon, code is enacted to then display the compact format in an expanded format. Furthermore, the Examiner notes the advertisement in Petropoulos (e.g. a particular website advertised via a search result URL responsive to a search query) is delivered to the client machine in a compact format (i.e. search result) as well as code that has been delivered to transition the compact format into the expanded format (i.e. preview window) ([0020-62]). Petropoulos further teaches functional attributes of the preview window (i.e. expanded format) including enabling a hyperlink so that a mouseover or a click on a link within a previewed page is active and results in a call to the referenced page. ([0042])

However, Petropoulos is silent to the newly amended limitations of "including the electronic advertisement in the second electronic document, where the electronic advertisement is included in less than an entire portion of the second electronic document. (*emphasis added*)

While the Examiner contends Petropoulos clearly shows the claimed compact format, expanded format, expansion icon as well as the menu options/hyperlinks included in the expanded format (i.e. preview window), the implementation of the instant invention that upon a user selection of a menu option in the expanded format for displaying, in a second document, content referenced by the selected menu option, and including the expanded format advertisement in less than an entire portion of the second document is neither disclosed in Petropoulos, nor would it have been obvious to implement as such at the time the invention was made.

6. The following is an examiner's statement of reasons for allowance of independent claims 1, 35 and 52-53 over the pertinent art reference of **Undasan (US 7,490,288 B2)** (**hereinafter Undasan**):

(1) Based on further search and consideration for newly amended claims 1, 35 and 52-53, the Examiner cites the prior art reference Undasan (US 7,490,288 B2) as pertinent art. The Examiner notes Undasan has not been applied to claims 1, 35 and 52-53 in any previous prior art rejection. Undasan teaches delivering a first electronic document (Fig. 2, "202") containing a hyperlink (Fig. 2, "204"). Upon a user mousing over the hyperlink, a first preview window (Fig. 2, "206") of the document referred to by the hyperlink is displayed to the user. This preview window can also contain hyperlink (Fig. 2, "208") which upon the user mousing over the hyperlink, a second preview document window (Fig. 2, "212") referred to by the hyperlink is displayed to the user, whilst retaining the display of the first preview window document ([0008-16], [0036-38]).

While the Examiner contends Undasan clearly teaches the functionality of displaying referenced content in a second electronic document (Fig. 2, "212") (i.e. via an advertisement hyperlink URL) whilst retaining the advertisement hyperlink URL (Fig. 2, "208") in view of the user with the referenced content, the implementation of the instant invention (i.e. "including the electronic advertisement in the second electronic document, where the electronic advertisement is

included in less than an entire portion of the second electronic document) is neither disclosed by Undasan, nor would it have been obvious to implement as such at the time then invention was made.

7. Prior to this issuance of allowance, a mandatory database search was performed. This search resulted in three pertinent references:

(1) The first reference was a foreign patent reference (WO/0225561 A2 directed towards a **METHOD OF LINKING ADVERTISEMENTS ON THE WORLD WIDE WEB WITH ADVERTISEMENTS IN OTHER MEDIA**) (hereinafter **Minte**). Minte teaches advertisement-specific content pages that include one or more advertisement-specific menu buttons which link the Web user to supplemental content webpages containing information related to the advertisement-specific menu buttons. These supplemental content webpages include information specific to the first advertisement, such as coupons, special offers, purchasing information, etc. ([0044], Fig. 3, Fig. 4).

The Examiner notes that while advertisement-related links, menu buttons, pull down menus, etc. are old and well-known in

an advertising webpage environment, implementing these menu buttons and referencing links in an advertisement in an expanded display format that has been transitioned from a compact display format via an expansion icon, and displaying the referenced content (i.e. supplemental content of Minte) and the expanded format advertisement in a second electronic document, where the advertisement is included in less than an entire portion of the second electronic document is neither disclosed by Minte, nor would it have been obvious to implement as such at the time the invention was made.

(2) The second reference was a Non-Patent Literature document ("**NY Times online ad model mimics print**", **Kate Maddox. B to B. Chicago: Dec 10, 2001. Vol. 86, Iss. 22; pg. 10, 1 pgs)** (hereinafter **Maddox**). Maddox teaches a program called Surround Session, a new online ad format this is based on sequential advertising. Surround Sessions give advertisers exclusive placement within content areas and follow unique users throughout their session at the site.

The Examiner notes that while sequential advertising is old and well-known in an advertising webpage environment, and while implementing this sequential advertising in a manner

which follows the user throughout their online activity, thereby garnering more attention from the user, may cover some of the claim limitations and solve some of the problems being addressed by the instant invention, implementing this sequential advertising in a manner such as the instant invention (i.e. in an advertisement in an expanded display format transitioned from a compact display format via an expansion icon, and displaying referenced content and the expanded format advertisement in a second electronic document, where the advertisement is included in less than an entire portion of the second electronic document is neither disclosed by Maddox, nor would it have been obvious to implement as such at the time the invention was made.

(3) The third reference was a Non-Patent Literature document ("**IAB, NAI Change Tactics on Ad Targeting**", **Mike Shields. Mediaweek. April 15, 2010.**) (hereinafter **Mediaweek**) The Examiner firstly notes that the priority of this publication fails to precede the priority of the instant invention; however, this reference is cited to further illustrate the patentable features of the instant invention. Mediaweek teaches running notices alongside banners in the form of text links that enable users to access more

information on where those ads came from. This is accomplished via a common clickable icon within or near online ads.

Advertisers or publishers can opt to have the icon drive users to separate web pages or to interstitials providing detailed explanations of why given ads have been served.

The Examiner notes that while clickable icons are old and well-known in an advertising webpage environment and that while the teachings of Mediaweek could satisfy some of the instant limitations (e.g. an advertisement in a compact display format and expansion icon), Maddox neither discloses, nor would it have been obvious to implement as such at the time the invention was made, the allowable features of the instant invention (i.e. an advertisement in an expanded display format containing menu options referencing content transitioned from a compact display format via an expansion icon, and displaying the referenced content and the expanded format advertisement in a second electronic document, where the advertisement is included in less than an entire portion of the second electronic document).

8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM A. BRANDENBURG whose telephone number is (571)270-5488. The examiner can normally be reached on Monday-Thursday 6:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. A. B./
Examiner, Art Unit 3622

/John Van Bramer/
John Van Bramer
Primary Examiner, Art Unit 3622